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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,716	11/13/2000	Stefano Faccin	NOKIA.29US	4655
43829 7590 09/03/2008 ROBERT M BAUER, ESQ. MacDonald Illig Jones & Britton LLP Suite 700 100 State Street Erie, PA 16507-1459			EXAMINER BEAMER, TEMICA M	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 09/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/709,716

**Applicant(s)**

FACCIN ET AL.

**Examiner**

TEMICA M. BEAMER

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-16, 20-24, 26-29, 41, 49, 50, 52, 53, 55, 56 and 61-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41, 49, 50, 52, 53, 55, 56 and 61-66 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-16, 20-24, 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 27 and 29 (and their corresponding dependent claims) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 20 and 24 of U.S. Patent No. 7,298,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to setting up a communication channel for transferring call related control messages.

**U.S. Patent 7,298,697**

**Instant Application**

1. A method of setting up a communication channel for transferring call related control messages in a packet switched wireless communications network, comprising the steps of: generating, in a first network element, a request to setup a communication channel; including in the request, in the first network element, a parameter indicating that said communication channel will be used for transferring call related control messages to or from said first network element; sending, from said first network element to a second network element, said request to setup a communication channel, said request having said indication indicating that the communication channel will be used for transferring call related control messages to or from said first network element; setting filtering information for said communication channel in response to said request to setup the

1. A method of providing location-based services for a call in a packet switched wireless communications network having at least one user equipment, the method comprising the steps of: sending a first request to setup a communication channel from the user equipment to a first network element, said first request having an indication that the communication channel will be used for transferring a call which requires location-based services; receiving the first request in a first network element; and selecting a second network element in accordance with said indication, wherein traffic on said communication channel is filtered according to filtering information set by said first network element or said second network element.

<p>communication channel; and filtering the messages sent on said communication channel in response to said filtering information set in response to receiving said request to set up said communication channel.</p>	
<p>20. A packet switched wireless communication network, comprising: a first network element generating a request to setup a communication channel and including in said request a parameter indicating that the communication channel will be used for transferring call related control messages to or from said first network element; and a second network element, said second network element receiving from said first network element, said request to setup a communication channel having an indication indicating that the communication channel will be used for transferring call related control messages to or from said first network element, said first network element or said second network element setting filtering information for said communication channel in response to receiving said request to set up said communication channel; and at least one of said first network element and said second network element filtering messages transferred on said communication channel according to said filtering information set in response to receiving said parameter.</p>	<p>27. A packet switched wireless communication network comprising: at least one user equipment; a first network element, said first network element receiving a first request to setup a communication channel sent from said at least one user equipment, said first request having an indication that the communication channel will be used for transferring a call requiring location-based services; and a second network element, said second network element being selected in accordance with said indication, wherein frame on said communication channel is filtered according to filtering information set by said first network element or said second network element.</p>
<p>24. A user equipment in a packet switched wireless communications network, said user equipment being adapted to: generate a request to setup a communication channel; include in the request, a parameter which indicates that said communication channel will be used</p>	<p>29. A network element in a packet switched wireless communication network, said network element configured to carry out a method comprising the steps of: receiving a request m setup a communication channel from a user equipment, said request having an</p>

for transferring call related control messages to or from said mobile station and that filtering information should be set in response to said request; and send, to another network element in said packet switched wireless communications network, said request to setup said communication channel, said request having the parameter indicating that the communication channel will be used for transferring call related control messages to or from said mobile station and that filtering information should be set in response to said request.	indication that the communication channel will be used for transferring a call which requires location-based services; and selecting another network element in accordance with said indication, wherein traffic on said is filtered according to filtering information set by said network element or said another network element.
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***Allowable Subject Matter***

3. Claims 1-4, 6-16, 20-24, 26-29 will be allowed once the double patenting rejection is overcome
4. Claims 41, 49, 50, 52, 5355, 56 and 61-66 are allowed.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TEMICA M. BEAMER whose telephone number is (571)272-7797. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Temica M. Beamer/  
Primary Examiner, Art Unit 2617